

Appl. No. 10/511,802
Final Amendment and/or Response
Reply to final Office action of 9 February 2007

Reply under 37 CFR 1.116
Expedited Procedure – TC 2838

Page 7 of 10

REMARKS / DISCUSSION OF ISSUES

Claims 2-5, 7-10, and 12-20 are pending in the application. Claims 1, 6, and 11 are cancelled herein.

The applicant respectfully requests the admittance of this amendment, to place the claims in a better condition for allowance or appeal. Claims 1, 6, and 11 are canceled; claims 2 and 9 are rewritten in independent form; and claim 12 is rewritten to include the limitations of canceled claim 11, upon which it had been dependent. Claims 5 and 15 are amended to correct typographical errors. The applicant respectfully notes that this amendment adds no new matter, and does not require an additional search, because the claims as rewritten are equivalent to their former form.

The Office action rejects claims 1-20 under 35 U.S.C. 102(b) over *Telefus et al.* (USP 5,694,304, hereinafter *Telefus*). The applicant respectfully traverses this rejection with respect to pending claims 2-5, 7-10, and 12-20.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Also, the Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the

Appl. No. 10/511,802
Final Amendment and/or Response
Reply to final Office action of 9 February 2007

Reply under 37 CFR 1.116
Expedited Procedure – TC 2838

Page 8 of 10

specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

The applicant respectfully reminds the Examiner that it is the duty of the Examiner to specifically identify each and every element and limitation of a claim in the cited reference as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. (See MPEP §706).

Independent claim 2 includes the limitation that a first transformer includes a first predetermined number of further secondary windings for supplying a first total power to associated loads, and the first total power is less than the power supplied by the secondary winding of the second transformer to the common load.

The Office has not established a *prima facie* case of anticipation with respect to independent claim 2 (formerly dependent claim 2 now in independent form). The Office action fails to show where *Telefus* teaches that a first transformer includes a first predetermined number of further secondary windings for supplying a first total power to associated loads, and the first total power is less than the power supplied by the secondary winding of the second transformer to the common load.

Independent claim 9 includes the limitation that one or more transformers of at least two transformers includes one or more additional secondary windings that are configured to supply non-zero current to ancillary loads.

The Office has not established a *prima facie* case of anticipation with respect to independent claim 9 (formerly dependent claim 9 now in independent form). The Office action fails to show where *Telefus* teaches that one or more transformers of at

NL-020334 R118 Amendment 7.209

Atty. Docket No. NL-020334

Appl. No. 10/511,802
Final Amendment and/or Response
Reply to final Office action of 9 February 2007

Reply under 37 CFR 1.116
Expedited Procedure – TC 2838

Page 9 of 10

least two transformers includes one or more additional secondary windings that are configured to supply non-zero current to ancillary loads.

Independent claim 15 includes the limitation that a primary winding of a first transformer, a primary winding of a second transformer and a resonance capacitor are arranged in series across an electronic switch.

The Office has not established a *prima facie* case of anticipation with respect to independent claim 15. The Office action fails to show where *Telefus* teaches that a primary winding of a first transformer, a primary winding of a second transformer, and a resonance capacitor are arranged in series across an electronic switch.

Because the Office action fails to show where *Telefus* teaches each limitation of independent claims 2, 9, and 15, the applicant respectfully maintains that the Office action has failed to establish a *prima facie* case of anticipation, and therefore the rejection of claims 2-5, 7-10, and 12-20 under 35 U.S.C. 102(b) over *Telefus* is unfounded, per MPEP 2131, and should be withdrawn.

The Final Office Action is not in compliance with 37 C.F.R. §1.104(c)(2) and MPEP 707 because the pertinence of *Telefus* with respect to former claims 2 and 9 (now independent form) and claim 15 were not clearly explained. The goal of prosecution has not been met under MPEP 706 because the Office has not clearly articulated its rejection so that the applicant could have the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. That is, the applicant may never have such an opportunity after final rejection (i.e., on appeal) or may only have such an opportunity only after the filing of an RCE which is too late. The applicant stresses that the Office's failure to explain how the rejected claims 2, 9, and 15 are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the cited reference *Telefus*, has resulted in reversal of a final rejection by the Board of Patent Appeals and Interferences. *Ex*

Appl. No. 10/511,802
Final Amendment and/or Response
Reply to final Office action of 9 February 2007

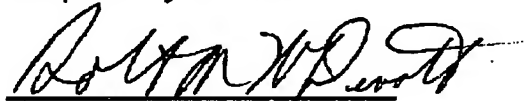
Reply under 37 CFR 1.116
Expedited Procedure – TC 2838

Page 10 of 10

Parte Naoya Isoda, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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